REMARKS

Claims 1, 3-6, 8, and 9 are pending in this application. Claims 1 and 6 are independent and have been amended. Claims 2 and 7 have been canceled. Reconsideration of the present application as amended is respectfully requested.

Interview

Examiner Hannet and Supervisor Examiner Garber are thanked for their time and courtesy they extended to Applicant's representative during the personal interview on January 5, 2004.

During the interview, the differences between the art of record and the present invention were discussed. While no agreement was reached, the Examiners clarified the motivation to combine the references and stated that the secondary reference is used just to teach that all images associated with a panoramic group can be collectively erased to save time. The Examiners further stated that it was common sense to collectively erase, as discussed in Takiguchi et al., the images instead of having to perform individual erase commands, as discussed in Toyofuku et al.

The Subject Matter of the Present Invention

In the present invention, a digital camera generally permits a captured image to be stored in a memory as an image file, wherein the stored images can be erased on a file-by-file basis from the memory. The present invention also can prevent an image that is part of multiple related images, such as panoramic images or a sequence of separate images, from being accidentally erased. Additional information concerning a selected image to be erased is referred to before erasure from the memory. If a selected image is prohibited from being erased independently, a display indicates to the user that the selected image relates to other images stored in the memory, thereby preventing the user from accidentally erasing a part of a panoramic image or a sequence of separate images.

Claim Status

Claims 1, 3-6, 8, and 9 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication No. 2001/0048465 to Toyofuku et al. in view of newly cited U. S. Patent No. 6,549,681 to Takiguchi et al. Applicant respectfully traverses this rejection.

Regarding the applied rejection against independent claims 1 and 6, Applicant respectfully submits that the Examiner failed to establish a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion of motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference must teach or suggest all the claim limitations, see *In re Vaeck*, 947 F.2d 48, 20 USPQ2d 1438 (Fed.Cir.1991).

Toyofuku et al. describes a device and method that include a warning when an individual image frame is selected to be erased. A protect code added to the image corresponds to the warning to inhibit erasure, see paragraph [0135]. Toyofuku et al. describes adding the protect code to individual images included in a panorama. There is no teaching or suggestion in Toyofuku et al. to warn the user that image to be deleted is part of a panoramic image. In order to prohibit the eraser of a panoramic image, each individual image must have a protect code, see paragraph [0149]. According to the Examiner, Toyofuku et al. does not teach or suggest a collectively deleting of all images associated with a

panoramic image simultaneously. Nor does Toyofuku et al. allow a user the option to erase all of the images related to a panoramic image simultaneously so that the user does not have to independently erase each of the pictures which wastes considerable amount of the user's time.

In the Office Action, the Examiner has indicated that Toyofuku et al. does not teach the following feature of Applicant's claimed invention that a decision device which decides whether to collectively erase a selected image and the plurality of images relating to the selected image from memory. Also, the Office Action indicates that Toyofuku et al does not teach or suggest an eraser that erases the selected image and at least one of the plurality of images relating to the selected image from the memory if the decision device decides to collectively erase the selected image from the memory and the at least one of the plurality of images relating to the selected image. Applicant respectfully agrees with the Examiner that Toyofuku et al does not teach or suggest these features as recited in amended claim 1.

Additionally, it is respectfully submitted that Toyofuku et al does not teach or suggest Applicant's claimed eraser which erases the selected image to be erased from the memory if the determination device determines that the selected image to be erased does not relate

to any of the plurality of images stored in the memory. Also, the eraser feature that prohibits the selected image to be erased from actually being erased independently if the determination device determines that the selected image to be erased relates to at least one of the plurality of images stored in the memory.

Similarly, Toyofuku et al does not teach features recited in method claim 6. For example, Toyofuku et al does not teach or suggest the step of deciding whether to collectively erase the selected image and the at least one of the plurality of the images relating to the selected image to be erased from the memory. Or the step of erasing the selected image and the at least one of the plurality of images relating to the selected image from the memory if it is decided to collectively erase the selected image and the at least one of the plurality of images relating to the selected image from the memory in the deciding step.

In the Office Action, the Examiner acknowledges that Toyofuku et al. fails to disclose or teach specific noted features as set forth in the independent claims. To overcome the deficiencies of Toyofuku et al. the Examiner cites to Takiguchi et al. and states that Takiguchi et al. teaches in column 57, lines 40-51, a "method of collectively deleting all images associated with a panoramic image simultaneously to also allow a user the option to erase all

of the images related to a panoramic image simultaneously so that the user would not have to independently erase each of the pictures and therefore, save the user time."

It is respectfully submitted that Takiguchi et al. appears to teach something entirely different than that summarized by the Examiner. Takiguchi et al. describes an ascertation that the thumbnail image belongs to the panoramic group (step S92) and starts a synthesization process. The synthesization process is performed to display a registered panoramic image.

More specifically, at step S91, a check is made if the thumbnail form represents a group for a panoramic image. Step S92 determines if the group can be synthesized to form a panoramic image. In step S93, if the panoramic group corresponds to the form, a thumbnail image of the thumbnail form is created. Hereafter, in step S94, the selected thumbnail of the panoramic group is deleted from the system 15 and a newly created panoramic image is registered. This newly created image is displayed at step S95.

According to the Examiner at the interview, Takiguchi et al. is merely used to demonstrate that all the images of a panoramic image can be simultaneously can be erased. Also, according to the

Examiner, it would be "common sense" to modify Toyofuku et al. after studying the previous noted section of Takiguchi et al.

The Examiner's rejection is based on a hindsight reconstruction of the prior art with the Examiner relying on the Applicant's own disclosure for providing the motivation to make the modification. Such a rejection is not sanctioned by the provisions of 35 USC 103.

As set forth in Section 2143.01, the eighth paragraph of the MPEP:

"If [a] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)."

Applicant respectfully submits that the proposed modification by the Examiner of Toyofuku et al. in view of Takiguchi et al. renders Toyofuku et al. unsatisfactory for its intended purpose and thus is not sanctioned by the provisions of 35 U.S.C. § 103. Indeed, Toyofuku et al. must be considered in its entirety including disclosures that teach away from the claimed invention. *See M.P.E.P. 2142.02.* If the proposed modification renders the Toyofuku et al. unsatisfactory for its intended purpose, then by definition, there is no suggestion or motivation to make the

proposed modification. *See M.P.E.P. 2143.01.* Thus, if the proposed modification renders Toyofuku et al. unsatisfactory for its intended purpose, the rejection must fail.

As noted previously, Takeguchi et al. forms a panoramic image from a panoramic group of thumbnail images. Once the image is formed and registered, the panoramic group of thumbnail images is deleted. This is different from Toyofuku et al. which does not form thumbnail images of the panoramic image, and utilizes header information to provide a protection code amongst other information, see paragraph [0105].

Any rejection based on assertions that a fact is well-known or is common knowledge in the art without documentary evidence to support the examiner's conclusion should be judiciously applied. It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based. See *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697; *Ahlert*, 424 F.2d at 1092, 165 USPQ 421.

In this instance, it appears that the only motivation to combine has been gleaned from the teachings of the present application. This constitutes impermissible hindsight, however. *See MPEP 2141.* Simply put, there is no showing in the Office Action that the conclusion of obviousness was reached on the basis

of facts gleaned from the prior art, and not from the claimed invention. *See MPEP 2143.*

Recent Federal Circuit case law precedent makes it explicitly clear that the factual question of motivation is material to patentability and cannot be resolved on subjective belief and unknown authority, but must be read on the objective evidence of the record. Federal Circuit case law precedent further requires that "common sense and common knowledge" alone is improper evidence in support of an obviousness rejection.

The Examiner purports a common sense and common knowledge reason for the deficiencies of Toyofuku et al., in other words, stating that Toyofuku et al. would have suggested a similar technique by looking at Takiguchi et al. However, common sense and knowledge are not objective evidence of record, as the Federal Circuit explains, but are in fact commensurate with subjective belief and unknown authority. Therefore, the Examiner has failed to meet the legal requirements to substantiate the obviousness rejection.

For an illuminating discussion on the burden placed on an Examiner to establish objective factual findings of record, the Examiner is referred to the recent Federal Circuit decision of *In re Lee*, 61 USPQ2d 1430 (CAFC 2002).

In re Lee involved an appeal of a decision of the Board of Patent Appeals in which *Lee* argued that the Examiner failed to provide a source of a teaching, suggestion, or motivation to combine the applied prior art to arrive at the claimed invention. The Board responded to these arguments by ruling that "[t]he conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference." *Id.* at 1432. The Federal Circuit overturned the Board's decision "for failure to meet the adjudicative standards for review under the administrative procedure act." *Id.* at 1431. The Federal Circuit further stated that "the factual inquiry whether to combine references must be thorough and searching...it must be based on objective evidence of record...[t]his precedent has been reinforced in a myriad of decisions and cannot be dispensed with." *Id.* at 1433. The Court also stated that the USPTO is "not free to refuse to follow Circuit precedent" and "cannot rely on conclusionary statements when dealing with particular combinations of prior art and specific claims." *Id.* at 1434.

As stated herein above, the Examiner's asserted modification for Toyofuku et al. which is to add a "method of collectively deleting all images associated with a panoramic image

simultaneously to also allow a user the option to erase all of the images related to a panoramic image simultaneously so that the user would not have to independently erase each of the pictures and therefore, save the user time," and the lack of factual support thereof comports very closely to the analysis disapproved by the Federal Circuit in *In re Lee*. As such, the Examiner's failure to provide factual support for a teaching, suggestion or motivation to modify Toyofuku et al. constitutes legal error.

Therefore, the combination of Toyofuku et al. and Takiguchi et al. is improper. Thus, independent claims 1 and 6 are distinguishable over Toyofuku et al. and Takiguchi et al.

Claims 3-5, 8 and 9 depend directly or indirectly from independent claims 1 and 6. Therefore, these dependent claims are also distinguishable over the combination of Toyofuku et al. and Takiguchi et al. for at least the reasons stated with respect to the independent claims.

Applicant respectfully requests withdrawal of the rejection of claim 1, 3-6, 8 and 9 under 35 U.S.C. §103 based on Toyofuku et al. and Takiguchi et al.

CONCLUSION

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. It is believed that a full and complete response has been made to the outstanding Office Action, and that the present application is in condition for allowance.

Should any issues remain, however, the Examiner is invited to telephone Daniel K. Dorsey (Reg. No. 32,520) at (703) 205-8000 in an effort to expedite prosecution.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17, particularly extension of time fees.

Respectfully submitted,

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